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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,007	10/10/2002	Colin Wesley Ward	7-02	5750

23713 7590 11/24/2004

GREENLEE WINNER AND SULLIVAN P C  
4875 PEARL EAST CIRCLE  
SUITE 200  
BOULDER, CO 80301

EXAMINER
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ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/070,007	Applicant(s) WARD ET AL.	
	Examiner Janet L. Andres	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24, 27-34, 39 and 41-58 is/are pending in the application.
- 4a) Of the above claim(s) 45-47, 52 and 55-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-34, 39, 41-44 and 58 is/are rejected.
- 7) ☒ Claim(s) 48-51, 53, 54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### RESPONSE TO AMENDMENT

1. Applicant's amendment filed 30 August 2004 is acknowledged. Claims 24, 27-34, 39, and 41-58 are pending in this office action. Claims 45-47, 52, and 55-57 are withdrawn from consideration as being drawn to a non-elected invention. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

#### *Claim Rejections/Objections Withdrawn*

2. The objection to the specification is withdrawn in response to Applicant's amendment.
3. The objection to claims 50 and 51 is withdrawn in response to Applicant's cancellation of these claims.
4. The rejection of claims 23-34, 41-44, and 53 under 35 U.S.C. 102(b) as anticipated by Reiter et al. is withdrawn in response to Applicant's cancellation of claims 23, 25, and 26 and amendment to claims 24, 27-34, and 41-44.
5. The rejection of claims 23-36, 41-44, and 53 under 35 U.S.C. 102(b) as anticipated by Maihle et al. is withdrawn in response to Applicant's cancellation of claims 23, 25, and 26 and amendment to claims 24, 27-34, and 41-44.
6. The rejection of claims 48-51 and 54 under 35 U.S.C. 103(b) as unpatentable over Reiter et al. or Maihle et al. in view of Ashkenazi et al. is withdrawn in response to Applicant's amendment to these claims.
7. The rejection of claims 23-44, 48-51, 53, and 54 under 35 U.S.C. 112, first paragraph, as lacking enablement commensurate in scope with the claims is withdrawn in response to Applicant's cancellation of claims 23, 25, 26, 35-38, and 40 and amendment to claims 24, 27-44, 48-51, 53, and 54.

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8. The rejection of claims 23-44, 48-51, 53, and 54 under 35 U.S.C. 112, first paragraph, as lacking written description is withdrawn in response to Applicant's cancellation of claims 23, 25, 26, 35-38, and 40 and amendment to claims 24, 27-44, 48-51, 53, and 54.

9. The rejection of claims 23-44, 48-51, 53, and 54 under 35 U.S.C. 112, second paragraph, as indefinite is withdrawn in response to Applicant's cancellation of claims 23, 25, 26, 35-38, and 40 and amendment to claims 24, 27-44, 48-51, 53, and 54.

***New Grounds of Rejection***

10. Claim 39 is newly rejected under 35 U.S.C. 102(b) as anticipated by Maihle et al.

Applicant has amended the claim so that there is no requirement that it lack any region. It merely comprises residues 1-501 or residues 1-513. Thus the claim is anticipated by any truncated receptor that is longer than residues 1-501. There are no functional limitations in this claim. However, in response to Applicant's arguments with respect to the "improper use of inherency", an inherent property need not be recognized in order for anticipation to occur. See

MPEP §2112.01:

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."

Since there is nothing that distinguishes the structure of the product claimed in claim 38 from that taught by the prior art, the product of the prior art would inherently have the same function as that instantly claimed.

11. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-34, 39, 41-44, and 58 are newly rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Because they do not require that the proteins be isolated, and because truncated proteins occur in nature, the claims encompass products of nature.

*Allowable Subject Matter*

12. Claims 48-51, 53, and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

CLAIMS 27-34, 39, 41-44, AND 58 ARE REJECTED. CLAIMS 48-51, 53, AND 54 ARE OBJECTED TO.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 571-272-0867. The examiner can normally be reached on Monday, Tuesday, Thursday, Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Andres, Ph.D.  
22 November 2004

  
**JANET ANDRES**  
**PRIMARY EXAMINER**